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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,579	12/18/2000	Tomoko Ishikawa	199648US0	9891

22850 7590 04/30/2002

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EXAMINER

NOTE, JANIS L

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 04/30/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

1122-9

# Office Action Summary

Application No.

09/737,579

Applicant(s)

ISHIKAWA et al

Examiner

J. DOTE

Group Art Unit

1756

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 5/22/01
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-56 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-56 are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some\* ☐ None of the:

☒ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-848
- ☐ Other \_\_\_\_\_

Office Action Summary

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-26, 31, 33, 35, 36, 39, 41, 43, 45, and 46-56, drawn to toners and a method of making toners, classified in class 430, subclass 110.2 and 137.14, respectively.

II. Claims 27-30, 32, 34, 37, 38, 40, 42, and 44, drawn to toners, classified in class 430, subclass 110.1.

2. The inventions are distinct, each from the other because of the following reasons:

Invention I (toner) and Invention II are distinct and separate inventions that are mutually exclusive of each other. Invention I is drawn to a toner comprising an agglomerate of particles comprising primary polymer particles and primary colorant particles, and a layer of particulate resin coated on a "substantial" surface portion of the agglomerate, wherein at least one of the primary polymer particles and particulate resin comprises a wax. Invention II is drawn to a toner comprising a binder resin and a particulate wax, wherein the particulate wax has a particular half-width of a number-average diameter and a particular distribution throughout the toner. Invention I does not require the particulate wax having the particular half-width of a number-average diameter and the particular distribution

required by Invention II. Invention II does not require the toner comprise the agglomerate of particles coated with a layer of particulate resin required by Invention I. Neither invention suggests the other.

Invention I (process) and Invention (II) are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make another and materially different product, such as the toner in Invention I comprising an agglomerate of particles comprising primary polymer particles and primary colorant particles, and a layer of particulate resin coated on a "substantial" surface portion of the agglomerate, wherein the primary polymer particles comprise a particulate wax. The process of Invention I does not require the use of a particulate wax having the particular half-width of a number-average diameter required by Invention II. Nor does the process require that the resultant toner have the particular distribution of particulate wax required by Invention II. Furthermore, the product in Invention II can be made by another and materially different process, such as a process comprising the steps of melt-kneading-pulverizing a

mixture comprising a binder resin and a particulate wax having the particular half-width of a number-average diameter required by Invention II to obtain resin particles, and coating the resultant particles with a polymer to form a shell on said particles.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and their different classification, restriction for examination purposes as indicated is proper.

3. A telephone call was made to Mr. Derek Mason (Reg. No. 35,270) on Apr. 24, 2002, to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must

be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (703) 308-3625. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (703) 308-2464. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9311 (Rightfax) for after final faxes, and (703) 872-9310 for other official faxes.

Any inquiry of papers not received regarding this communication or earlier communications, or of a general nature or relating to the status of this application or proceeding should be directed should be directed to the Customer Service Center of Technology Center 1700 whose telephone number is (703) 306-5665.

JLD  
April 28, 2002

*Janis L. Dote*  
JANIS L. DOTE  
PRIMARY EXAMINER  
GROUP 1500  
F700